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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,842	09/05/2006	Peter Hupfield	DC10005 PCT1	3322
137 7590 03/03/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER				
BUIE, NICOLE M				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

**Office Action Summary****Application No.**

10/591,842

**Applicant(s)**

HUPFIELD, PETER

**Examiner**

NICOLE M. BUJE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

Claims 1-13 remain pending in the application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 1**, it is unclear where the olefinically unsaturated group of an aminosiloxane is to be found in the final polymeric reaction product.

***Claim Rejections - 35 USC § 102***

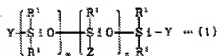
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

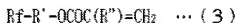
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-2, 5-7, and 9-13** are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (JP 08-109580, see machine translation for citation).

**Regarding claims 1-2, 5-7, and 9-10** Ohashi et al. discloses a composition in claim 1 comprising a polymeric reaction product of i) an aminosiloxane containing amino groups of the formula as shown below:



wherein Y is an amino alkyl group which anticipates the formula of claim 6 and R<sup>1</sup> is a monovalent hydrocarbon group with 1-20 carbon atoms wherein R<sup>1</sup> is the same or different and may be chosen from alkenyl groups, vinyl group, or allyl group as well as alkyl groups [0008], and ii) a fluoro-substituted alkyl ester of an ethylenically unsaturated carboxylic acid of the following formula:



wherein R'' of Ohashi et al. is hydrogen or a methyl group, R' of Ohashi et al. is unsubstituted or substituted, divalent hydrogen group with 1-10 carbon atoms, and Rf of Ohashi et al. is a univalent perfluoroalkyl group and/or perfluoro polyether group with 3-15 carbon atoms.

**Regarding claim 11**, Ohashi et al. discloses a composition wherein a fluoroalkyl ester component is at least 0.2 times the molar amount to the hydrogen atom of nitrogen binding in amino group content of aminopolysiloxane (claim 1). Specifically in Synthetic Example 1, Ohashi et al. discloses a composition comprising about 34 wt% of an aminosiloxane and 66 wt% of fluoro-substituted alkyl ester [0021].

**Regarding claim 12**, Ohashi et al. discloses a textile treatment composition [0001].

**Regarding claim 13**, Ohashi et al. discloses a process for rendering cloth oleophobic [0001].

***Response to Arguments***

Applicant's arguments filed 11/10/2008 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art. The following comments apply:

A) Morita emphasizes free radical chemistry with certain silicon-containing polymerizable compounds (see Applicant's arguments, P3), therefore the previous rejection of Westall in view of Morita has been withdrawn.

***Allowable Subject Matter***

**Claims 3-4 and 8** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the closest prior art of record, Ohashi et al. teaches a composition comprising a polymeric reaction product of an aminosiloxane and fluoro-substituted alkyl ester. However, Ohashi et al. does not teach or suggest a polymeric reaction product comprising a -CH<sub>2</sub>CHR"-COO-X-OOC-CR"=CH<sub>2</sub> group or amino groups modified by reaction with a lactone, epoxide, isocyanate or anhydride. Therefore, claims 3 and 8 are deemed nonobvious over the prior art of record.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./  
Examiner, Art Unit 1796  
2/23/2009

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796